

U.S. Patent Application No. 09/900,533
Request for Reconsideration dated May 25, 2006
Response to Office Action dated February 27, 2006

REMARKS/ARGUMENTS

Reconsideration and continued examination of this application are respectfully requested.

Rejection of Claims 25-32, 34-40, 42-54, and 56-59 Under 35 U.S.C. §112, First Paragraph

At page 2 of the Office Action, the Examiner rejects claims 25-32, 34-40, 42-54, and 56-59 under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement.

The Examiner alleges that the present application does not teach that the pH of the fluid compositions may be at a level of 9 to 14, when only an acid is used in the fluid. For the following reasons, this rejection is respectfully traversed.

The present application, including the claims as originally filed, does clearly provide a written description of the pH range set forth in claims 25 and 34 and the claims dependent thereon. For instance, at page 18, lines 6-15 of the present application, the application teaches an alkali metal formate, such as cesium formate, in the form of a completion fluid. This paragraph does not place any limitations with respect to the other ingredients that may be present with the alkali metal formate in the completion fluid. This paragraph states that the chelating agent can be present; meaning the chelating agent is optional. Further, the paragraph states that the pH of the composition, which refers to the completion fluid in this paragraph, can be "any pH." Further, the paragraph continues by stating that the pH of the completion fluid can be, in preferred embodiments, from about 9 to about 14: "Preferably, the pH of the completion fluid is from about 9 to about 14, and more preferably from about 11 to about 13." (Emphasis added). There is no requirement in this paragraph that a chelating agent must be present and, clearly, this paragraph refers to the completion fluids described in the present application. Furthermore, at page 24, lines 9-12 of the present application, the application

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teaches that "[f]or purposes of the present invention," the completion fluid can contain at least alkali metal formate and at least chelating agent or at least one acid or both. Spent completion fluids are also referred to in this paragraph and elsewhere. Clearly, the present application teaches that the "completion fluid" includes an embodiment with an alkali metal formate and an acid, and, as referenced above, in the paragraph at page 18, lines 6-15, the "completion fluid" can have the pH range set forth in the claims rejected by the Examiner. In addition, at the paragraph beginning at page 24, lines 13-21, there is a further teaching that the completion fluids of the present invention (without limit to any ingredients) can have a high pH. Thus, there are numerous teachings in the present application to clearly support the claims rejected by the Examiner. Certainly, these disclosures reasonably convey to one skilled in the art that the inventors had possession of the claimed invention as set forth in claims 25-32, 34-40, 42-54, and 56-59.

At page 3 of the Office Action, the Examiner addresses applicants' arguments against this rejection, which is reiterated above, by alleging that claim 25 teaches the embodiment starting on page 20, line 11, of the specification, where no chelating agent is present. The Examiner further alleges that this embodiment concludes at page 22, lines 4-5, of the specification. Unfortunately, the Examiner did not specifically address the arguments previously presented and did not provide any reason why the above-indicated support does not satisfy §112.

The applicants would like to point out to the Examiner that claim 25 recites optionally at least one chelating agent, instead of excluding a chelating agent as the Examiner suggests. In addition, the applicants respectfully note that the term "chelating agent," as described in the present application, clearly encompasses many acids and, therefore, for this additional reason, the present application clearly discloses a higher pH range, as an option, for completion fluids containing at least one alkali

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metal formate with an acid and surfactant. The applicants respectfully disagree with the Examiner's comments that the embodiment of claim 25 is only limited to the disclosure found at page 20, line 11, to page 22, lines 4-5. Clearly, other parts of the application relate to the embodiment of claim 25 as indicated above. For instance, and to specifically rebut the Examiner's comments, the disclosure at page 24, beginning at line 9, clearly relates to the embodiment of claim 25. Further, the fact that page 24, lines 9-12, relates to what is considered to be "the completion fluid" of the present invention, many other disclosures in this application clearly relate to the embodiment of claim 25. Thus, the applicants believe that the Examiner is incorrect with respect to the position taken by the Examiner. When the application is considered in its entirety, including the sections identified above, clearly support for the rejected claims can be found in the present application to satisfy §112, first paragraph. Applicants respectfully submit that the Examiner did not consider applicants' arguments above, which shows that at least one embodiment is disclosed for a completion fluid that can contain an acid and a pH range as recited in claim 25.

The above arguments equally apply to the rejection of independent claim 34 and its dependent claims. For these reasons, the rejection should be withdrawn.

Provisional Obviousness-Type Double Patenting Rejection of Claims 1, 3, 5-18, 20, and 22-24

At page 3 of the Office Action, the Examiner provisionally rejects claims 1, 3, 5-18, 20, and 22-24 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of co-pending U.S. Patent Application Number 10/216,048. For the following reasons, this rejection is respectfully traversed.

Since this is a provisional rejection and since this will be the only rejection pending, it is

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proper to withdraw this provisional rejection in the present application so that the present claims can issue into a patent. As the M.P.E.P. instructs, this obviousness-type double patenting rejection, if proper, can then be raised in co-pending Application No. 10/216,048. However, the applicants note that the claims in co-pending Application No. 10/216,048 recite an alkali metal tungstate, which is not recited in the present claims. The claims in each application would not be obvious to each other. The provisional rejection does not appear to be proper for this reason as well.

At page 4 of the Office Action, the Examiner attempts to address applicants' arguments against this rejection by alleging that the claims of U.S. Patent Application No. 10/216,048 may comprise an alkali metal formate and not only a tungstate. Applicants respectfully submit that the Examiner's reason here for making this rejection is erroneous. Just because a claim in U.S. Patent Application No. 10/216,048 recites that it comprises an alkali metal formate does not negate the fact that it recites a tungstate, which the claims of the instant application do not recite. The difference between having a tungstate, as well as other different components, concentration, and/or pH ranges, in a composition can be a significant difference. The Examiner has not provided a reason or a teaching for why the presence or absence of tungstate, among other differences between the claims, is obvious. For these reasons, the rejection should be withdrawn.

In view of the above comments, the applicants believe that all claims are in condition for allowance and that the provisional obviousness-type double patenting rejection can be removed at this time as stated above.

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CONCLUSION

In view of the foregoing remarks, the applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

If there are any fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 03-0060. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,



Luke A. Kilyk
Reg. No. 33,251

Atty. Docket No. 00087CIP (3600-295-01)
KILYK & BOWERSOX, P.L.L.C.
400 Holiday Court, Suite 102
Warrenton, VA 20186
Tel.: (540) 428-1701
Fax: (540) 428-1720